

In re Application of: Christoph KIRSCH, et al.  
Confirmation No.: 3234  
Application No.: 09/831,272  
Page 9 of 11

## REMARKS

### Restriction Requirement

In the above-identified Office Action, the examiner set forth a restriction requirement and required election of one of the following groups under 35 U.S.C. § 121:

- Group I. Claims 1, 3-7, 9-15, 17-21, 30, 31 and 39, drawn to chimeric promoter, vectors cells and plants comprising cis element comprising SEQ ID NO 3 or SEQ ID NO: 4, classified in class 536, subclass 24.5.
- Group II. Claims 2, 3, 8, 9, 22, 39 and 42-45, drawn to chimeric promoter, vectors, cells and plants comprising cis element comprising SEQ ID NO 11, classified in class 536, subclass 24.5.
- Group III. Claims 16 and 33-34, drawn to a method of producing transgenic plants or pathogen resistant plants using Group I, classified in class 435, subclass 419.
- Group IV. Claims 23-27 drawn to a method for identification of modulators of promoters comprising cis elements of Group I, classified in class 435, subclass 6.
- Group V. Claims 28, 30 and 32, drawn to a compound identified by the method of Group IV, classified in class 514, subclass 1.
- Group VI. Claim 29-31, drawn to an antibody recognizing the compound of Group II, classified in class 530, subclass 387.9.
- Group VII. Claims 29-31, drawn to an antibody recognizing the cis element of Group IV, classified in class 530, subclass 387.9.
- Group VIII. Claims 33 and 46, drawn to use of Group II to generate transgenic plants or pathogen resistant plants, drawn to class 435, subclass 419.
- Group IX. Claim 33 and 40, drawn to use of Group V to generate pathogen resistant plants, drawn to class 435, subclass 419.

{WP260129:1}

In re Application of: Christoph KIRSCH, et al.  
Confirmation No.: 3234  
Application No.: 09/831,272  
Page 10 of 11

Group X. Claims 35-38, drawn to a method of preparing a promoter by operably linking a cis-element sufficient to direct elicitor-specific expression into a promoter, classified in class 435, subclass 91.41.

In response, Applicants elect Group II, Claims 2, 3, 8, 9, 22, 39 and 42-45, drawn to chimeric promoter, vectors, cells and plants comprising cis element comprising SEQ ID NO 11, classified in class 536, subclass 24.5. This election is made with traverse.

The Examiner asserts that Groups II and VIII are different inventions. However, applicants submit that the chimeric promoter, vectors, cells and plants comprising cis element comprising SEQ ID NO 11, of Group II when used according to the methods of claims 33 and 46, of Group VII result in the production of the transgenic plants. The method of Group VIII utilizes the elements as recited in Group II to produce the transgenic plants when the recited method is used. A search of the elements of Group II would also result in a search of the methodology and production of these same plants. That is, the end result of the elements in Group II are the essential components (i.e. chimeric promoter, vectors, cells and plants comprising cis element comprising SEQ ID NO 11) used in the steps of the method of production of the plant and, ultimately yielding the desired plant of the invention. A search based on Group II would ultimately yield the end result of Group VIII and would therefore, not be an undue burden. Applicants respectfully submit that the lifting of the restriction requirement, and prosecuting Groups II and VIII would result in a significant savings of time and resources for both the Patent Office and Applicants. In view thereof, Applicants respectfully request lifting of the Restriction requirement and request rejoinder of Groups II and VIII.

The elected claims set forth, herein, are merely to comply with the Restriction Requirement and is not to be construed as surrender of any subject matter in the instant application. Applicants hereby reserve the right to pursue the subject matter of the canceled or withdrawn claims in one or more divisional patent applications. Based on the above election, Applicants request removal of the restriction requirement and substantive examination of all elected claims. Applicants invite the Examiner to call the undersigned

{WP260129;1}

In re Application of: Christoph KIRSCH, et al.  
Confirmation No.: 3234  
Application No.: 09/831,272  
Page 11 of 11

if it is believed that the above restriction election is incomplete or improper in any way,  
or if a telephonic interview will expedite the prosecution of the application to an  
allowance.

This response is being filed with a petition for a one month retroactive of time and  
the required fee. Although, Applicants believe that no further extensions of time are  
required with submission of this paper, Applicants request that this submission also be  
considered as a petition for any further extensions of time if necessary. The  
Commissioner for Patents and Trademarks is hereby authorized to charge the amount due  
for any retroactive extensions of time and any deficiency in any fees due with the filing  
of this paper or credit any overpayment in any fees paid on the filing or during  
prosecution of this application to Deposit Account No. 50-0951.

Respectfully submitted,  
AKERMAN SENTERFITT



Date: September 28, 2005

Nicholas A. Zachariades, Ph.D.  
Reg. No. 56,712  
AKERMAN SENTERFITT  
P.O. Box 3188  
West Palm Beach, FL 33402-3188  
Tel: 561-653-5000

Docket No. 9730-1

{WP260129:1}